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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,887	04/16/2001	Paola Lenti	1011-287	4551
47888	7590	10/12/2005	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			PIERCE, JEREMY R	
		ART UNIT	PAPER NUMBER	
		1771		

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/835,887	LENTI, PAOLA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeremy R. Pierce	1771	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 04 August 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 32 and 33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed on August 4, 2005 has been entered. Claims 29-31 have been cancelled, rendering the rejections set forth against them in the last Office Action moot. New claims 32 and 33 have been added and are currently pending.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 32 recites "a top face on which a woven or non-woven material top layer is arranged, said top layer having a top surface comprising a woven and dyed wool felt having smear resistant properties." Claim 33 recites a similar limitation. In response the 112, 2<sup>nd</sup> paragraph rejection made to a similar recitation of a now cancelled claim, Applicant submitted that the top layer can be woven or not woven, whereas its top surface is constituted by a woven and dyed wool felt. However, support for such a top

layer is not found in the Specification. Nowhere is there described a woven or non-woven fabric top layer having a top surface constituted by a woven and dyed wool felt. Although Applicant has explained why the claim limitation is not indefinite, Applicant has done so in a manner that reads new matter into the claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 32 and 33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "said molecular laminate coating element" in line 12 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 32 recites "a plurality of adhesive strips each having a bottom face so processed as to prevent said molecular laminate coating element from slipping on smooth floor and wall surfaces." It is unclear what type of "adhesive strip" is necessary to meet this claim limitation. Applicant does not discuss in the Specification the type of adhesive strip needed to prevent slipping on a smooth floor or wall surface. The Specification does point to using Velcro strips and bi-adhesive strips, so it would seem to apply that strips comprising adhesive rather than Velcro would be needed to meet the limitation. However, claim 33, which depends upon claim 32, recites "a plurality of tearable adhesive strips each having a bottom face" which prevents slippage on a smooth floor or wall surface. Now the adhesive strips are recited as being "tearable," which leads one to believe that Velcro should be used instead of adhesive. Clarification

is requested, but Applicant should be mindful of avoiding an interpretation that would read as new matter.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. (U.S. Patent No. 4,263,727) in view of Latzke (U.S. Patent No. 4,887,368), Dessaint et al. (U.S. Patent No. 4,295,976), Fisher et al. (U.S. Patent No. 5,611,153), and Cohen (U.S. Patent No. 4,187,621).

Bender et al. disclose a web of natural or synthetic fibers that is flame-laminated to closed-cell polyolefin foam (column 1, lines 31-35) without the use of adhesive (column 2, lines 31-33). In a preferred embodiment, closed-cell polyethylene foam is combined with an upper layer of woven cotton fabric and a lower layer of nonwoven nylon (column 2, lines 62-68).

Although Bender et al. disclose the top layer can be a woven cotton fabric (column 2, line 65), the reference does not disclose it to be a woven wool fabric that is dyed and smear resistant. Latzke discloses that woven wool, as well as woven cotton can be used as a skin compatible layer in a shoe insole (column 7, lines 42-46). It would have been obvious to one having ordinary skill in the art to use woven wool as

the top layer in the insole of Bender et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. It would also have been obvious to dye the wool fabric any desired color for use as a shoe insole. Neither Latzke nor Bender et al. disclose a smear resistant property in the upper layer. Dessaint et al. disclose that a stain resistant property may be imparted onto textile fabrics, including woven and nonwoven articles of cotton and wool (column 7, lines 36-45). It would have been obvious to one having ordinary skill in the art to add a stain-resistant agent to the top layer of Bender et al. in order to improve likelihood of avoiding stains, as taught by Dessaint et al.

Bender et al. also do not disclose the bottom layer having a bottom to which are coupled a plurality of adhesive strips. Fisher et al. disclose an insole material made from closed-cell polyolefin foam (column 3, lines 25-65). Fisher et al. teach that the bottom of the insole can be treated with adhesive materials or Velcro-type fasteners to provide non-slip features for attachment into a shoe (column 4, lines 62-67). It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the insole of Bender with adhesive strips in order to provide a non-slip feature to the insole, as taught by Fisher et al.

Although Bender et al. does not disclose the top layer to have projecting and recessed patterns, Latzke shows that the insole material is preferably made with recessed areas to better accommodate a foot (see Figures 15 and 16). It would have been obvious to a person having ordinary skill in the art at the time of the invention to

provide the insole of Bender et al. with recessed areas in order to make the insole more comfortable for the wearer. Bender et al. do not disclose that the shoe insole is die cut with a contour mold. Cohen teaches an insole for shoes where the layers are flame-bonded together and then cut and conformed in contour with various thickness (Claim 1), so Cohen also recognizes the importance of molding with recessed areas and projected areas. It would have been obvious to one having ordinary skill in the art to use the method of forming a shoe insole disclosed by Cohen in the insole of Bender et al. in order to create a shoe insole that better fits the wearer's foot.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 32 and 33 have been considered but are moot in view of the new ground(s) of rejection. Although Applicant asserts that an insole could not slip since it would be restrained from slipping by the confined inner surface of the shoe upper, the newly cited Fisher reference teaches that it is known in the art of shoe insoles to provide anti-slip features to the bottom surface.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: GB 2,011,837 to Wilhelm et al. teaches wall covering comprising closed-cell polyethylene foam that is flame laminated to outer paper layers and provided with a textured surface.

Art Unit: 1771

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on normal business hours, but works flextime hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*JRP*  
Jeremy R. Pierce  
October 5, 2005

*Elizabeth M. Cole*  
ELIZABETH M. COLE  
PRIMARY EXAMINER